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09/479,653	01/10/2000	HIDETOSHI WADA	35.C14165	- 3352

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EXAMINER

VENT, JAMIE J

ART UNIT	PAPER NUMBER
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2613

DATE MAILED: 09/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/479,653

Applicant(s)

WADA ET AL.

Examiner

Jamie Vent

Art Unit

2613

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Specification***

1. The title of the invention is objected to. A new title is required that is clearly indicative of the invention to which the claims are directed in a more detailed form.

### ***Drawings***

2. The drawings are objected to due to Figure 3 not appropriately labeling the recording device 200 as depicted correctly in Figure 2. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1, 2, 5, 6, 7, 8, 9, 10, and 11 are rejected under 35 U.S.C. 102(a) as being anticipated by Mattes (US 6,038,295).

3. In regard to Claim 1, Mattes discloses an image communication apparatus for recording, communicating, and administering digital images comprising:

Art Unit: 2613

- image pickup means for generating digital image (Column 2 Lines 36-38 "recording the images by a digital image pick up unit which is included in the telephone unit, converting the images to digital form as digital stored image");
- recording means for recording the digital image and list information corresponding to the digital image, in a recording medium (Column 3 Lines 60-63 "the received digital images may be stored in lists or directories in the server which are classified according to the time at which the image was acquired.." The examiner notes that the server, as seen in Figure 1, has a memory and other components that embodies it as recording medium);
- transmitting means for exciting wireless transmission of the digital image and list information recorded in the recording medium to an external apparatus (Column 2 Lines 11-14 "A transmission system is coupled to the telephone unit and to a server for transmitting of the data which includes the digital images and potentially the classification information (lists)"); and
- an image communication apparatus has a mode of automatically executing wireless transmission of the digital image and list information recorded in the recording medium, in accordance with a communication state with the external apparatus (Column 6 Lines 16-20 "...provide a mode key MT by which the operating mode of the telephone unit TE is switched

such as between operation as a normal telephone or as an image pick up and transmitting unit according to the present communication system.”

The examines notes that transmitting of the image and list would occur automatically when in appropriate operating mode; however, would not transmit when the phone is in “normal telephone mode”, out of the service area, or turned off).

4. In regard to Claim 2, Mattes further discloses a mode that automatically executes a wireless transmission of the digital image and list information if the communication state is good (Figure 3 Step 303 image and classification information (lists) are transmitted from the telephone unit TE to the server S via the transmission system. The transmission system can be operated “wirelessly as a mobile telephone using an antenna A for transmission and reception of the data (Column 6 Lines 37-38)).

5. In regard to Claim 3, Mattes further discloses a mode that automatically executes wireless transmission of the digital image and list information if said image pickup means is not in an image pickup state (Column 6 Lines 17-20 “...mode key MT by which the operating mode of the telephone unit TE is switched such as between operation as a normal telephone or an image pickup and transmitting unit...” The examiner takes official notice that transmitting of the image and list would not occur if the operating mode was set as a normal telephone, out of the service area, or turned off).

Art Unit: 2613

6. In regard to Claim 6, Mattes further discloses an image communication apparatus controls the mode in accordance with a program stored in recording medium (Column 3 Lines 17-18 "...user may provide the classification information which is allocated to the digital images and which identify the digital images).

7. In regard to Claim 7, Mattes further discloses the list information is generated for each of the digital image ("...received digital images may be stored in lists or directories in the server.")

8. In regard to Claim 8, Mattes further discloses the list information includes any one of an image pickup date and time and a title (Figure 4 depicts the information that is provided within the classification information/lists).

9. In regard to Claim 9, Mattes further discloses the digital image includes any one of a moving and a still image (Column 1 Lines 56-57 "still pictures and/pr moving pictures can be recorded..").

10. In regard to Claim 10, Mattes further discloses that transmitting means has a function of spread spectrum communication method (Column 3 Lines 9-10 "wirelessly transmits the data over the transmission system." It is known in the art that spread spectrum communication is a means of transmission in which the data sequences occupy a bandwidth in excess of the minimum bandwidth necessary to send it. It is also

Art Unit: 2613

noted cellular phones by transmitting the data wirelessly through a bandwidth uses spread spectrum communication method as its communication method).

11. In regard to Claim 11, Mattes further discloses that the image communication apparatus is a camera integrated digital video recorder or a digital camera (Column 8 Lines 39 "digital camera).

Claims 12, 13, 14, 15, 16, 17, 18, 19, 20, and 21 are rejected under 35 U.S.C. 102(a) as being anticipated by Squilla et al (US 6396537).

12. In regard to Claim 12 Squilla et al discloses an image communication apparatus comprising:

- receiving means for receiving list information supplied from an external apparatus through wireless transmission (Figure 2 shows the following apparatuses receiving/transmitting information: camera, image server, and server shown in Lines 60, 72, 74a, 74b);
- recording means for recording the list information (Figure 2 each apparatus has a memory location used for recording list information and images);
- comparing means for comparing the list information with other list information recorded and control means for remotely controlling image information corresponding to the list information in accordance with a

comparison result by said comparing means (Column 6 Lines 57-63  
“personality file is used by the image server and image spot to choose  
content data as the user visits respective image spots and captures  
images”. It is seen that the personality file (list information) is comparing  
the user’s interest and location in park to control the information given to  
the user and using the comparison of user’s interest and the location in  
the park to inform an image spot about a visitor’s particular interest.)

13 In regard to Claims 13 and 14, Squilla et al further discloses a request not to  
reproduce or to delete the image information corresponding to the list information,  
according to comparison result (Figure 4 shows the camera and scene is determined if  
content is of interest via personality file and image database. If content is not desired it  
will skip reproduction and be sent to URL for retrieval if needed at a later time or the  
option of deletion by either the user or system).

14. In regard to Claim 15, Squilla et al further discloses the list information includes  
any one of an image pickup date and time and a title (Figure 7 depicts the information of  
the image data which encompasses many fields including: name, date, time, title, GPS,  
etc).



Art Unit: 2613

15. In regard to Claim 16, Squilla et al further discloses the image information includes any one of a moving image and a still image (Column 7 Line 46 content information includes collection of movies).

16. In regard to Claim 17, Squilla et al further discloses receiving means having a function of spread spectrum communication method. (Figure 2 shows the receiving and transmitting of signals wirelessly through antennas (20 and 82). It is inherent that spread spectrum communication is a means of transmission in which the data sequences occupy a bandwidth in excess of the minimum bandwidth necessary to send it. It is also noted that this apparatus transmits the data through interchangeable signals therefore using the method of spread spectrum communication.

17. In regard to Claim 18, Squilla et al further discloses a storage device (Column 4 Lines 32-35 "removable memory, such as a memory card or a small hard drive card".)

18. In regard to Claim 19, Squilla et al discloses an image communication method comprising:

- generating digital image by using an image pickup unit (Figure 1 Object 44 generates image signal from the captured image);
- recording the digital image and list information corresponding to the digital image in a recording medium (Column 4 Lines 31 digital image and information stored in image recording memory).

- controlling a mode of automatically executing wireless transmission of the digital image and list information recorded in the recording medium to an external apparatus, in accordance with a communication state with the external apparatus (Column 4 Lines 54-58 when the digital camera is brought into communicating range of the image spot an exchange takes place between camera and image spot via a wireless link).

19. In regard to Claim 20, Squilla et al discloses an image communication method comprising:

- receiving list information supplied from an external apparatus through wireless communication (Figure 2 list being received via wireless links 74a, and 74b are received by a transceiver (80) through an antenna (82));
- recording the list information (Figure 2 the data received is stored in the content database (86));
- comparing the list information with other list information recorded at said recording step (Figure 2 microprocessor (76) compares the information recorded); and
- remotely controlling image information corresponding to the list information in accordance with a comparison result at said comparing step (Figure 2 interface (78) controls the image information with information received from the user through the camera via the image server).

Art Unit: 2613

20. In regard to Claim 21, Squilla et al discloses an image communication system comprising:

- image generating apparatus for recording digital image and list information corresponding to the digital image generated by an image pickup unit, in a first recording unit (Figure 2 the microprocessor (42) records image produced by A/D converter (46), user interface, and the image list provided by personality files (52) that is stored on memory (48) or viewed through the LCD (50) which makes up the image generating apparatus (24));
- a recording apparatus for recording the digital image supplied from said image generating apparatus through wireless transmission, in a second recording medium (Figure 2 shows wireless transmission from object 10 to object 70 via line 74a. Object 70 has a recording apparatus of a writer (92) that records images and information into a recording medium of cds);
- said image generating apparatus is provided with a first mode of automatically executing wireless transmission of the list information recorded in the first recording medium, according to a communication state with said recording apparatus (Column 4 Lines 54-58 "When the digital camera is brought into the communicating range of the image spot and a photograph is taken at that spot, an exchange takes place between the camera and the image spot via a wireless link); and

Art Unit: 2613

- recording apparatus is provided with a second mode of receiving the list information supplied from said image generating apparatus through wireless transmission and remotely controlling the digital image corresponding to the list information (Figure 2 Object 70 receives the list information supplied from the image generating unit (24) through wireless transmission (line 74a) and once data has been processed remotely controlling the digital image corresponding to the list information via the data terminal (object 97)).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mattes in view of Squilla et al (US 6396537).

21. In regards to Claims 3 and 4 Mattes discloses an image communication for recording, communicating, and administering digital images but lacks a method to either skip reproduction of digital image or delete the digital image recorded by the external

Art Unit: 2613

apparatus. Squilla discloses a photographic system for enabling interactive communication. As seen in Figure 4 the photo and then determined if scene and content of interest, via the personality file, is needed. The content is reviewed via the user in step 104 via the camera LCD and is then decided by user or by apparatus if content is desired. If content is undesired the image will not be reproduced (downloaded to computer) but sent to the URL. The URL is used for the image to be retrieved if needed at a later time or for the images to be deleted by the user or the system. It would be obvious to one skilled in the art at the time of the invention to modify the image communication system of Mattes and incorporate the option of skipping reproduction or deleting image by the apparatus, as taught by Squilla et al, that would allow for more space for photographs and list information due to the removal of undesired photos.

### **Conclusion**

22. The prior art made of record and not relied upon are considered pertinent to applicant's disclosure. The following is considered of significant interest to the application:

- Wakui (6262767) still video with remote controller;
- Brusewitz et al (6038257) video picture transmission and display

Art Unit: 2613

**Contact Fax Information**

*Any response to this action should be mailed to:*

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*Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA., Sixth Floor (Receptionist).*


**Contact Information**

*Any inquiry concerning this communication or earlier communications from the  
examiner should be directed to Jamie J. Vent whose telephone number is (703) 305-  
0378.*

*If any attempts to reach the examiner by telephone are unsuccessful, the examiners  
supervisor, Christopher Kelley, can be reached at (703) 305-4856.*

*Any inquiry of a general nature or relating to the status of this application should be  
directed to the Group receptionist whose telephone number is (703) 305-4700.*

Jamie Vent  
08/22/2003

  
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